

REMARKS/ARGUMENTS

Claims 1-18 and 21 - 60 are currently pending. Claims 1, 16, 38, and 49 have been amended. Claims 19 and 20 were previously canceled. Claims 56 - 60 have been added.

The instant amendment is being filed with a Request for Continued Examination.

Claims 31 - 37 and 54 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-5, 7, 9-10, 16-17, 26-28, 38-46, 48-53, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels (U.S. Patent No. 6,417,840) in view of Stork et al. (U.S. Patent No. 6,275,174) [Stork '174].

Claims 6 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels and Stork '174 in view of Liu (U.S. Patent No. 6,133,907).

Claims 8, 11-15, 18-19, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels and Stork '174 in view of Stork et al. (U.S. Patent No. 6,181,329) [Stork '329].

Claims 22-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels and Stork '174 in view of Buchner et al. (U.S. Patent No. 5,532,753).

Applicant respectfully submits that claims 31 - 37 and 54 are enable and comply with 35 U.S.C. § 112, first paragraph. Applicant directs the Examiner's attention to FIG. 7 and its attendant description for the enablement of claims 31 - 37 and 54. Specifically, at page 34, lines 15 - 18 a movement detection unit 720 is described as being a mechanical mouse assembly, an optical mouse assembly, a trackball assembly, a touch pad assembly, or a gyroscopic assembly. Also, at page 34, line 19 to page 35 line 1, position sensors 735 are described as being rollers, photosensors, touch sensors, or gyroscopes. Note that in FIG. 7, the movement detection unit 720 and the position sensors 735 are both coupled to the RF module 740 via the microcontroller unit 725. Also, note that the movement detection unit 720 and position sensors 735 may be different types of devices that may provide different control signals (i.e., first and second control signals) to the RF unit for transmission to a computer device. Therefore,

Applicant submits that the description at the above noted pages and FIG. 7 provide enabling description for claim 31 - 37 and 54.

Moreover, it is particularly pointed out that the “position sensors” 735 are described in the application at page 34, line 20 to page 35, line 35 and in FIG. 7 as plural devices. Note that “positions sensors 35” may be a plurality of devices that includes: “rollers, photosensors, touch sensors, or gyroscopes,” (see page 34, line 20 to page 35, line 35). These sensors may provide different control signals to a computer via the RF antenna to which they are coupled as shown in FIG. 7. Therefore, for the reasons described above, as well as these additional reasons, the application as originally filed at page 34, line 20 to page 35, line 35 and FIG. 7 provide enabling description for claims 31 - 37 and 54. Therefore, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 112, first paragraph rejection of claims 31 - 37 and 54.

Claim 1 as amended is not rendered obvious by Daniels and Stork '174 as these references fail to show or suggest “a user-operable power control switch having a first power-control state configured to supply power to the electronic control device, a second power-control state configured to supply power to the coherent light source, and a third power control state configured to provide power substantially simultaneously to the electronic control device and the coherent light source for substantially simultaneously operating the electronic control device and the coherent light source,” as recited in amended claim 1.

Daniels describes a control device that is configured to power either a control element or a laser but not both substantially simultaneously. Moreover, the control device of Daniels provides for automatic power switching between the control element and the laser. The automatic power switching device of Daniels is not operable by a user for selecting between three power options. Therefore, Daniels fails to render amended claim 1 obvious.

Stork '174 does not make up for the deficiencies of Daniels. As an initial matter, nowhere does Stork show or suggest a control device configured to substantially simultaneous power a laser and a rotary knob. The Examiner asserts that because the Stork device is configured to be operable by two hands that the Stork device is configured for simultaneous

operation of a laser and a rotary knob. Applicant respectfully disagrees. As an initial matter, nowhere does Stork '174 expressly state that the laser and rotary knob are simultaneously operational. Secondly, one of skill in the art would understand that the control buttons on the side of the Stork '174 control device are to be operated by a second hand because the rotary knob is configured for use by a user's "thumb and index finger," (see Stork '174 at col. 5, lines 52 - 54). That is, as the rotary knob is configured for operation by a thumb and index finger, a user's three other fingers (i.e., lower fingers) on the same hand are used to hold the control device to prevent the control device from falling to the floor and breaking. Not only is a user likely to drop and break the control device while holding the control device with their lower three fingers if the control buttons are operated by the user lower three fingers as the lower three fingers hold the control device, also operation of the four Stork '174 control button would be awkward and likely painful by a user's lower three fingers. Therefore, a user would use a second hand to operate the control buttons. Therefore, absolutely no inference would be drawn by one of skill in the art that the laser and rotary knob of Stork '174 are configured for simultaneous operation. Therefore, absolutely no inference would be drawn by one of skill in the art that merely because the Stork '174 control device is operable by two hands that the laser and rotary knob are configured to be operable substantially simultaneously. For at least this reason, Stork '174 fails to make up for the deficiencies of Daniels. Therefore, Daniels and Stork '174 fail to render claim 1 obvious.

As an additional matter, nowhere does Stork '174 disclose a user operable switch that is configured to allow a user to select operation of a laser, a electronic control device, or both the laser and electronic control device. Therefore, for at least this additional reason Stork '174 fails to make up for the deficiencies of Daniels. Therefore, Daniels and Stork '174 fail to render claim 1 obvious.

As claims 38 and 49 have been amended to recite similar limitations as those of claim 1 that are distinguished from Daniels and Stork '174 above, Daniels and Stork '174 fail to render claim 38 and claim 49 obvious.

Applicant further points out that one of skill in the art would not be motivated to combine the devices of Daniels and Stork '174 because i) these devices would be rendered

unsatisfactory for their intended uses and ii) because Stork '174 teaches away from being combined with a control device that includes a roller device or the like. The Examiner indicates that a motivation for combining or modifying references may be found in some teaching, suggestions, or motivation found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Applicant would add to this that if the references would be rendered unsatisfactory for their intended purpose, or if the reference teaches away from their combination, then there is no suggestion to one of skill in the art to combine the references. See MPEP section 2143.01 under the heading, "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE" (citing *In re Gulery*, 27 F.2d 55, 554). Also see MPEP section 2145, subsection X, sub-subsection D, paragraph 2, titled "References Cannot be Combined Where References Teach Away from Their Combination," (citing *In re Grasselli*, 713 F.2d 731, 743).

Assuming *arguendo* that Stork '174 does discuss a control device configured to power a laser and the a rotary knob substantially simultaneously, the Daniels device is configured to conserve battery power of one or more low power batteries by providing power to only one of a laser and a mouse ball. See Daniels at col. 1, lines 50 - 55, col. 3, lines 30 - 35, among numerous other places. This power conservation scheme of Daniels would be entirely defeated if both the laser and the mouse ball of Daniels were simultaneous powered. Because the power conservation scheme of Daniels would be rendered unsatisfactory for its intended purpose, there is absolutely no suggestion provided to one of skill in the art to combine Daniels and Stork '174. Therefore, for at least this additional reason, Daniels and Stork '174 fail to render claim 1 obvious.

Moreover, Stork '174 teaches against combination with a device that includes a track ball or joystick as these types of control require precise control that diverts a user attention from their presentation and "frequently lead to errors in operation," see Stork '174 at col. 2, line 57 to col. 3, line 5. Therefore, Stork '174 teaches away from combination with a control device, such as the control device of Daniels, that includes a roller ball or a joystick. Because Stork teaches away from this combination, there is absolutely no motivation or suggestion to one of skill in the art to combine these references regardless of a perceived enhanced function.

Therefore, these references cannot be combined as the references teach away from their combination, see MPEP section 2145. Therefore, for at least this additions reason, Daniels and Stork '174 fail to render claim 1 obvious.

Moreover, for at least these foregoing reasons, Daniels and Stork '174 fail to render claims 16, 31, 38, and 49 obvious.

Applicant further notes, that amended claim 16 is not rendered obvious by Daniels and Stork '174 as these references fail to show or suggest "the first presentation module and the second presentation module are configured to be separable, the first presentation module including a first power source and a first battery contact, and the second presentation module including a second power source and a second battery contact the first and second battery contacts are configured to contract if the first presentation module and the second presentation module are combined, and the first power source and the second power source are shared by the first presentation module and the second presentation module," as recited in amended claim 16. Nowhere do Daniels or Stork '174 show or suggest a separable device, or a separable device that on combination is configured to share power between the combined portions of the device via battery contacts. Therefore, Daniels and Stork '174 fail to render claim 16 obvious.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

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Amendment

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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